

REMARKS

The Office action dated December 1, 2003 and the cited references have been carefully considered.

Status of the Claims

Claims 5, 6, and 32-34 are pending. Claims 32 and 33 are canceled. Therefore, claims 5, 6, and 34 remain in the current prosecution.

Claim 6 is allowed.

Claims 33 and 34 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

Claims 5, 32, and 33 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

Claims 5, 32, and 33 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claim 5, 32, and 33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Webb et al. (U.S. Patent 3,011,870; hereinafter "Webb").

The Applicants respectfully traverse all of these rejections with respect to the remaining claims for the reasons set forth below.

Claim Rejection Under 35 U.S.C. § 112, First Paragraph

Claims 33 and 34 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement because the specification does not disclose how to make metal compounds other than oxide. Claim 33 is canceled. Therefore, the rejection of this claim is now moot. Claim 34 is amended to recite at least one oxide of

a rare earth metal. Therefore, claim 34 now overcomes this rejection and is in condition for allowance.

Claims 5, 32, and 33 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to enable which Periodic Table of the Elements is referred to. Claims 32 and 33 are canceled. Therefore, the rejection of these claims is now moot. Claims 5 is amended to recite explicitly gallium, indium, and thallium, which are disclosed in the original specification, and which belong to Group IIIA, as designated by the International Union of Pure and Applied Chemistry (IUPAC). Therefore, claim 5 now overcomes this rejection and is in condition for allowance.

Claim Rejection Under 35 U.S.C. § 112, Second Paragraph

Claims 5, 32, and 33 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite because "it is unclear which metals are included by the recitation of Group IIA of the Periodic Table of the Elements." Claims 32 and 33 are canceled. Therefore, the rejection of these claims is now moot. Claims 5 is amended to recite explicitly gallium, indium, and thallium, which are disclosed in the original specification, and which belong to Group IIIA, as designated by the International Union of Pure and Applied Chemistry (IUPAC). Therefore, claim 5 now overcomes this rejection and is in condition for allowance.

Claim Rejection Under 35 U.S.C. § 103(a)

Claims 5, 32, and 33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Webb '870. Claims 32 and 33 are canceled. Therefore, the rejection of claims 32 and 33 is now moot. The Applicants respectfully traverse this rejection because Webb '870 does not teach or suggest all of the limitation of each of claim 5.

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." M.P.E.P. § 2143.03, p. 2100-128 (8th ed., Rev. 1, Feb. 2003).

Webb discloses only alpha-aluminum oxide, but does not teach or suggest oxides of gallium, indium, thallium, rare earth metals, and mixtures thereof, as is recited in claim 5. In addition, there is no disclosure in Webb that would indicate needles of any other oxides could be made by his process that would meet the recited shapes and dimensions.

Since Webb '870 does not teach or suggest all of the limitations of claim 5, this claim is patentable over Web '870 under 35 U.S.C. § 103(a).

In view of the above, it is submitted that the claims are patentable and in condition for allowance. Reconsideration of the rejection is requested. Allowance of claims at an early date is solicited.

Respectfully submitted,



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